



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,461	09/25/2000	ANDREW R. COKER	169.1858	2130

5514 7590 10/24/2003

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
----------

POON, KING Y

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 10/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/668,461

Applicant(s)

COKER, ANDREW R.

Examiner

King Y. Poon

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-16,18-30,32,34-44 and 46-52 is/are rejected.
- 7) ☒ Claim(s) 7,9,17,31,33 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2624

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because using the word "said" in line 6 is not appropriate. Correction is required. See MPEP § 608.01(b).
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 47 recites the limitation "a computer readable memory medium" in line 1. There is insufficient antecedent basis for this limitation in the claim because claim 25 does not have a computer readable memory to be according to.

Art Unit: 2624

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 8, 10, 12-16, 18, 19, 21-30, 32, 34, 36-44, 46, 48, 50-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosekrans et al (US 5,450,571).

Regarding claim 1: Rosekrans teaches a printing system (fig. 1) comprising: storage means (memory, column 4, lines 5-10) in a client computer (client, column 4, line 6; 15 of fig. 6) for storing a client service item file (interclient job ticket, column 4, line 6) which comprises a set of user selectable service items, (e.g., one set of print attribute according to printer 12-1, column 4, lines 53-59, and another set of print attribute according to printer 12-2, column 4, lines 60-62, depending on the user's selection, column 4, lines 12-19, column 4, lines 38-68, column 5, lines 1-10, column 5, lines 57-65) each service item comprising a set of printing attributes (e.g., stock size, type and color, column 4, line 57); wherein the client service item file is updated (updated by masking file, column 4, lines 63-68, column 5, lines 1-10) in accordance to communication with an external apparatus (server 25, column 5, lines 35-40, fig. 6); a client computer user interface (column 3, lines 21-25) by means of which a user can select a particular one of the service items (service items are selected by selecting a print queue, column 5, lines 58-60) having a particular set of printing attributes (selections, column 6, lines 58-63); and a client computer print process

Art Unit: 2624

driver (the software of client, column 6, lines 11, that converts job selections into job ticket 35-1, column 4, lines 14-30, and the software that sends the mask file with inter-client ticket to and AND process, column 5, lines 57-66) adapted to process a print job (print job, column 3, lines 29-37, job selections is programmed into 35-1, column 4, lines 24-30) according to particular set of printing attributes (the user selected printing attribute/selections, column 4, lines 15-20, column 4, lines 25-30).

Regarding claim 2: Rosekrans teaches a printing system wherein the external apparatus (server 25, fig. 6) comprises a print application (the communication device of server 25 that communicates the mask file 55 to the client 15, fig. 6) adapted update (column 5, lines 5-10) the client service item file (interclient job ticket, fig. 6) on the basis of a server service item file (mask file, fig. 6) associated with a plurality of printers (column 5, lines 30-33) each printer supporting printing attributes of at least one of the user selectable service items (column 5, lines 57-61); and print the processed print job on a specific printer (column 4, lines 20-37) supporting the particular set of printing attributes of the particular selected service item. (The selected set of printing selections, column 4, lines 15-20)

Regarding claim 3: Rosekrans teaches wherein the communication is over a network (column 3, lines 25-28) comprising one of: a dedicated connection (communication channels 27); a local area network; and a wide area network.

Regarding claim 4: Rosekrans teaches wherein the user interface is conformed to the selected service item dependent upon the user selection. (Column 5, lines 57-65)

Art Unit: 2624

Regarding claim 5: Rosekrans teaches wherein the external apparatus further comprises: a server (server, column 5, lines 11-20) having storage means (inherent properties of a server) for storing the server service item file (mask file, fig. 6), wherein the server service item file (mask file, column 5, lines 30-33) is updated dependent upon a change to the plurality of printers, (set up, column 5, lines 30-35) an update label (the conditions that controls the generating of a new mask file, column 5, lines 25-35) being assigned to the updated server service item file.

Regarding claim 6: Rosekrans teaches wherein the update label is a time stamp (time to generate updated mask file, column 5, lines 30-33) indicative of a time of updating the server service item file.

Regarding claim 8: Rosekrans teaches wherein the print process driver (the software of client, column 6, lines 11, that converts job selections into job ticket 35-1, column 4, lines 14-30) comprises: a file data conversion process (converts from job ticket 35 to 35-1, column 4, lines 20-30, fig. 3) adapted to convert the print job using the particular set of printing attributes thereby producing print file data matched to the specific printer.

Regarding claim 10: Rosekrans teaches wherein the conversion process comprises conversion of the print job, being in a first page description language, (the print job selection in a display program language, column 4, lines 12-30) to the print file data, being in a second page description language. (Fig. 3)

Art Unit: 2624

Regarding claim 12: Rosekrans teaches print job storage means for storing (column 4, lines 30-31) the processed print job on the client computer in anticipation of the printing by the print application (print by printer, column 2, lines 25-32).

Regarding claim 13: Rosekrans teaches wherein the printing attributes relate to at least one of physical attributes (e.g., print stock size, column 4, lines 46) of a printer, and generic attributes (e.g., print stock, column 4, line 46) the printer.

Regarding claim 14: Rosekrans teaches wherein the printing attributes comprise at least one of: a service item name; an associated icon name; a page layout attribute; a single sided attribute; a two-sided attribute; a page size attribute; a print resolution attribute; a paper type attribute; an ink type attribute; a page orientation attribute; a color definition; a printed medium definition; a paper dimension; and at least one of top, bottom, left and right margin attributes. (Fig. 5)

Regarding claim 15: Rosekrans teaches wherein the particular service item is associated with an explanatory graphical icon. (E.g., the dimming or not dimming the icon, column 6, lines 55-60, fig. 5)

Regarding claim 16: Rosekrans teaches wherein the client service item file updating is performed upon the communication being established between the print application, (the communication device of server 25 that communicates the mask file 55 to the client 15, fig. 6), the server, (the server that sends the mask file, column 5, lines fig. 6) and the print process driver. (the software of client, column 6, lines 11, that converts job selections into job ticket 35-1,

Art Unit: 2624

column 4, lines 14-30, and the software that sends the mask file with inter-client ticket to and AND process, column 5, lines 57-66)

Regarding claim 18: Rosekrans teaches a print process driver (the software of client, column 6, lines 11, that converts job selections into job ticket 35-1, column 4, lines 14-30, and the software that sends the mask file with inter-client ticket to and AND process, column 5, lines 57-66) adapted to process a print job according to a particular set of printing attributes, (e.g., stock size, type and color, column 4, line 57) the attributes characterizing a particular service item (e.g., one set of print attribute according to printer 12-1, column 4, lines 53-59, and another set of print attribute according to printer 12-2, column 4, lines 60-62, depending on the user's selection, column 4, lines 12-19, column 4, lines 38-68, column 5, lines 1-10, column 5, lines 57-65) selected by a user from a client service item file (interclient job ticket, column 4, line 6) which comprises a set of user selectable service items, (e.g., one set of print attribute according to printer 12-1, column 4, lines 53-59, and another set of print attribute according to printer 12-2, column 4, lines 60-62, depending on the user's selection, column 4, lines 12-19, column 4, lines 38-68, column 5, lines 1-10, column 5, lines 57-65) each service item comprising a set of printing attributes, the client service item file being stored in a storage means (memory, column 4, lines 5-10) in a client computer, (client, column 4, line; 15 of fig. 6) wherein the client service item file is (updated by masking file, column 4, lines 63-68, column 5, lines 1-10) in accordance to communication with an external apparatus (server 25, column 5, lines 35-40, fig. 6).



Art Unit: 2624

Regarding claim 19: Rosekrans teaches wherein the processing of the print job comprises conversion of the print job, being in a first page description language, (the print job selection in a display program language, column 4, lines 12-30) to the print file data, being in a second page description language. (Fig. 3)

Regarding claim 21: Rosekrans teaches wherein the printing attributes relate to at least one of physical attributes (e.g., print stock size, column 4, lines 46) of a printer, and generic attributes (e.g., print stock, column 4, line 46) the printer.

Regarding claim 22 Rosekrans teaches wherein the printing attributes comprise at least one of: a service item name; an associated icon name; a page layout attribute; a single sided attribute; a two-sided attribute; a page size attribute; a print resolution attribute; a paper type attribute; an ink type attribute; a page orientation attribute; a color definition; a printed medium definition; a paper dimension; and at least one of top, bottom, left and right margin attributes. (Fig. 5)

Regarding claim 23: Rosekrans teaches wherein the particular service item is associated with an explanatory graphical representation. (E.g., the dimming or not dimming the icon, column 6, lines 55-60, fig. 5)

Regarding claim 24: Rosekrans teaches wherein the client service item file updating is performed upon the communication being established between the print application, (the communication device of server 25 that communicates the mask file 55 to the client 15, fig. 6), the server, (the server that sends the mask file, column 5, lines fig. 6) and the print process driver.

Art Unit: 2624

(the software of client, column 6, lines 11, that converts job selections into job ticket 35-1, column 4, lines 14-30, and the software that sends the mask file with inter-client ticket to and AND process, column 5, lines 57-66)

Regarding claim 25: Rosekrans teaches a method of printing a print job (print job, column 3, lines 29-37) comprising steps of: storing, in a storage means (memory, column 4, lines 5-10) in a client computer (client, column 4, line 6; 15 of fig. 6), a client service item file (interclient job ticket, column 4, line 6) which comprises a set of user selectable service items, (e.g., one set of print attribute according to printer 12-1, column 4, lines 53-59, and another set of print attribute according to printer 12-2, column 4, lines 60-62, depending on the user's selection, column 4, lines 12-19, column 4, lines 38-68, column 5, lines 1-10, column 5, lines 57-65) each service item comprising a set of printing attributes (e.g., stock size, type and color, column 4, line 57); updating (updated by masking file, column 4, lines 63-68, column 5, lines 1-10) the client service item file in accordance to communication with an external apparatus (server 25, column 5, lines 35-40, fig. 6); selecting, by a user by means of a client computer user interface (column 3, lines 21-25) a particular one of the service items (service items are selected by selecting a print queue, column 5, lines 58-60) having a particular set of printing attributes (selections, column 6, lines 58-63); and processing, by a client computer print process driver (the software of client, column 6, lines 11, that converts job selections into job ticket 35-1, column 4, lines 14-30, and the software that sends the mask file with inter-client ticket to and AND process, column 5, lines 57-66) a print job (print job, column 3, lines 29-37, job selections is programmed into 35-1, column 4, lines 24-

Art Unit: 2624

30) according to particular set of printing attributes (the user selected printing attribute/selections, column 4, lines 15-20, column 4, lines 25-30).

Regarding claim 26: Rosekrans teaches updating (updated by masking file, column 4, lines 63-68, column 5, lines 1-10) the client service item file, by a print application (the communication device of server 25 that communicates the mask file 55 to the client 15, fig. 6) in the external apparatus, on the basis of a server service item file (mask file, fig. 6) associated with a plurality of printers (column 5, lines 30-33) each printer supporting printing attributes of at least one of the user selectable service items (column 5, lines 57-61); and printing the processed print job on a specific printer (column 4, lines 20-37) supporting the particular set of printing attributes of the particular selected service item. (The selected set of printing selections, column 4, lines 15-20)

Regarding claim 27: Rosekrans teaches wherein the communication is over a network (column 3, lines 25-28) comprising one of: a dedicated connection (communication channels 27); a local area network; and a wide area network.

Regarding claim 28: Rosekrans teaches conforming the user interface to the selected service item dependent upon the user selection. (Column 5, lines 57-65)

Regarding claim 29: Rosekrans teaches updating the server service item file dependent upon a change to the plurality of printers (set up, column 5, lines 30-35); and assigning an update label (the conditions that controls the generating of a new mask file, column 5, lines 25-35) to the updated server service item file. (Mask file, fig. 6)

Art Unit: 2624

Regarding claim 30: Rosekrans teaches wherein the update label is a time stamp (time to generate updated mask file, column 5, lines 30-33) indicative of a time of updating the server service item file.

Regarding claim 32: Rosekrans teaches wherein the processing step comprises sub steps of: converting the print job (converts from job ticket 35 to 35-1, column 4, lines 20-30, fig. 2) using the particular set of printing attributes; and producing print file data matched to the specific printer.

Regarding claim 34: Rosekrans teaches wherein the converting step comprises a step of page description (fig. 3) converting the print job, being in a first page description language, (the print job selection in a display program language, column 4, lines 12-30) to the print file data, being in a second page description language. (Fig. 3)

Regarding claim 36: Rosekrans teaches prior to the printing step, a further step of: storing the processed print job on the client computer. (column 4, lines 30-31)

Regarding claim 37: Rosekrans teaches associating the particular service item with an explanatory graphical icon. (E.g., the dimming or not dimming the icon, column 6, lines 55-60, fig. 5)

Regarding claim 38: Rosekrans teaches updating the client service item file dependent upon the communication being established between a print application, (the communication device of server 25 that communicates the mask file 55 to the client 15, fig. 6), the server, (the server that sends the mask file, column 5, lines fig. 6) and the print process driver. (the software of

Art Unit: 2624

client, column 6, lines 11, that converts job selections into job ticket 35-1, column 4, lines 14-30, and the software that sends the mask file with inter-client ticket to and AND process, column 5, lines 57-66)

Regarding claims 39-44, 46, 48, 50-52: Rosekrans teaches a program (column 6, line 11) for controlling the client in performing the method steps discussed in claims 25-30, 32, 34, 36-38. Inherently, a program is saved in a computer readable memory medium. Please see discussion of claims 25-30, 32, 34, 36-38.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11, 20, 35, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosekrans et al as applied to claims, 1, 8, 10, 18, 19, 25, 32, 34, 39, 46, 48 above, and further in view of Sperry et al (US 5,995,723).

Regarding claims 11, 20, 35, 49: Rosekrans teaches to generate print jobs in Postscript.  
(Fig. 3)

Art Unit: 2624

Rosekrans does not teach wherein the first page description language is Windows® GDI and the second page description language is Postscript.

Sperry, shows a similar printer, client, server, configurations, (fig. 1, column 7, lines 1-5, lines 30-37, teaches to convert print job from GDI to other PDL. (Column 7, lines 38-50)

Since a GDI is a Microsoft program used for displaying objects to a user, and a Postscript is a PDL; it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Rosekrans' method of converting display objects into printer language to include: converting Windows® GDI into Postscript.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Rosekrans' by the teaching of Sperry because of the following reasons: (a) it would have allowed the client computer to use Microsoft application to create print jobs; and (b) being able to use Microsoft programs would have provided users with a huge benefit because Microsoft is one of the biggest computer software companies in the world, and would have provided users with the biggest selection of application programs for generating the print job.

***Allowable Subject Matter***

Art Unit: 2624

10. Claims 7, 9, 17, 31, 33, 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 7: The present invention is directed to updating client service item file, in a client computer, from a server service item file, in a server, wherein "the updating is performed if a time stamp associated with the client service item file is older than the time stamp of the server service item file." The closest prior art, Rosekrans et al (US 5,450,571); disclosed updating client service item file, in a client computer, from a server service item file, in a server; either singularly or in combination with other cited references, fails to anticipate or render the above limitations to be used with other claimed limitations obvious.

Regarding claim 17: The present invention is directed to updating client service item file, in a client computer, from a server service item file, in a server, wherein "wherein the update label is a version number, and wherein the client service item file updating is performed dependent upon a version number of the server service item file." The closest prior art, Rosekrans et al (US 5,450,571); disclosed updating client service item file, in a client computer, from a server service item file, in a server; either singularly or in combination with other cited references, fails to anticipate or render the above limitations to be used with other claimed limitations obvious.

Regarding claims 31, 45: The present invention is directed to updating client service item file, in a client computer, from a server service item file, in a server, wherein "time stamp updating

Art Unit: 2624

the client service file with respect to the server item file if a time stamp associated with the client service item file is older than the time stamp of the server service item file.” The closest prior art, Rosekrans et al (US 5,450,571); disclosed updating client service item file, in a client computer, from a server service item file, in a server; either singularly or in combination with other cited references, fails to anticipate or render the above limitations to be used with other claimed limitations obvious.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sanchez et al (US 5,784,177) teaches a printer driver allows users to select print attributes.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892.

October 7, 2003

*King Y. Poon*